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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,389	02/21/2001	Mitsuru Nakajima	1614.1127	5409

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/788,389	Applicant(s) NAKAJIMA ET AL.	
	Examiner Harish T. Dass	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,7 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,7 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 5-6, 8-13 are cancelled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 7 and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mital (US 5,903,652) in view of Kipp (US 5,890,136).

Re. Claims 14 and 19, Mital discloses checking, at an authentication system in response to accesses to the authentication system from terminal devices of the users, whether each of the users satisfies conditions for conducting a prospective transaction [Abstract; C3 L40-L53; C4 L27-L60; C5 L14-L25 – see for auditing functions];

transmitting respective, different matching keys from the authentication system to the terminal devices [C2 L40 to C3 L20; C4 L56-L61; C12 L50 to C13 L8 – see electronic mail module functions];

inputting, into a given one of the terminal devices, one of the matching keys that has been transmitted to and received by another one of the terminal devices and transmitting said one of the matching keys from said given one of the terminal devices to the authentication system and receiving a first one of the matching keys;

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receiving an input indicative of a second one of the matching keys that has been transmitted to and received by another one of the terminal devices [C1 L52-L57; C2 L40-L62; C22 L35-L57 – see sends an electronic message ...; a matching key is then used; public key, digital signature, private key];

checking, at the authentication system, whether said one of the matching keys matches one of the transmitted matching keys [C2 L17-L39 – see verify Carl's digital signature by comparing the digitally signed portion of the document with Carl's public key]; and

notifying said one of the terminal devices a result of the checking of the matching keys [C29 L44-L51 - see merchant computers, GetOrder Function, and indicates that the data ...].

Mital does not explicitly disclose If identical transaction keys are selected on screens of the terminal devices and if each of the users satisfies the conditions, said different matching keys being generated based on the identical transaction keys. However, Kipp discloses this feature [Fig. 2, Fig. 3 # 108, Fig. 4 #112, 114, 116, 118 ; C6 L39 to C7 L64] to automatically verify the customer identification to release the goods (provide service) for the proper customer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Mital and include identical transaction keys are selected on screens of the terminal devices and if each of the users satisfies the conditions, said different matching keys being generated based on the identical transaction keys, as disclosed by Kipp, to

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provide an automatic verification system to authenticate the buyer before providing the goods or services.

Re. Claims 15-18 and 20, claims 15-18 and 20 are system, apparatus and computer-readable medium claims substantially similar to method claims 14 and 19, therefore claims 15-18 and are rejected with same rational as claims 14 and 19.

Re. Claim 2, Mital discloses wherein the authentication system authenticates identities of the users prior to supplying a first user with the matching key [C4 L47 to C5 L25; C10 L36-L47].

Re. Claims 3-4, Mital discloses credit confirmation for a transaction (proposed transaction is within a previously determined credit) and payment authorization (wherein the authentication system determines whether the prospective transaction satisfies previously determined conditions for a transaction) [Figures 7-8A; C5 L50 to C6 L7; C8 L43-L57; C14 L54 to C15 L7] Mital does not explicitly disclose monetary limit. However, this step is commonly known to credit card holders and financial institutions issuing credit cards and is commonly know as credit limit (daily debit limit for ATM users), which are predetermined by the financial institutions to prevent over charging, loss and theft. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Mital and include monetary limit to

assure the transaction is within the credit limit granted to the cardholder for avoid major loss.

Re. Claim 7, Mital discloses providing payment of the transaction based on the matching results the authentication system [C1 L2 to C3 L9; C8 L43 to C9 L4; C29 L59 to C30 L65].

Response to Arguments

Applicant's arguments with respect to claims have been considered but they are not persuasive. Examiner has interpreted the claim limitations with reasonable broadest interpretations based on what is claimed not what is disclosed in the applicant's specification. for example, in response to Applicant argument that Mital is not an authentication system. Mital discloses a secure transaction system includes an electronic commerce service which authenticates the encryption keys make the Mital system an authentication system with broadest interpretation (col. 4 line 62 to col. 5 line 13; col. 5 lines 3-13; col. 20 line 65 to col. 21 line 5; col. 21 lines 18-27; col. 22 lines 35-45), Mital system uses RSA encryption technique (col. 18 lines 11-31) for generating keys which can be loaded on computer network accessible to both merchant and consumer.

Examiner has tried his best to includes page numbers and lines to help Applicant to locate at least one relevant passage of the prior art and limitation where could be found with reasonable broadest interpretation for example, the term authentication is interpreted in its broadest term which includes encryption and two keys (public key and private key) used in secure transaction between the consumer and merchant. Applicant

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must consider entire prior art for teaching of the limitations in addition to examiner's quoted reference.

In response to applicants argument that Mital does not disclose if identical transaction keys are selected on screens of the terminal devices and if each of the users satisfies the conditions, said different matching keys being generated based on the identical transaction keys is disclosed by secondary reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case verify the customer identification.

Applicant's request for reconsideration has been considered but the claims and claimed limitations as they are presented do not place the application in condition for allowance, because the claims and claimed limitations are too broad and do not present what the applicant arguments are about. The office action is for the claimed limitations not for what is not claimed. Applicant's argument of prior arts analysis is for what does prior art do, and does not include what claimed limitation is missing or not taught.

Examiner recommends that Applicant should present claims that accurately reflect the invention as they are disclosed in specification with limitations (not broad limitation) in clear way instead of broader language such as: "keys", "authentication system", etc. which are widely used in prior arts.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

In response to this office action Applicant must add a statement that no new matter is added.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693

9/1/06

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Examiner
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HTD


ELLA COLBERT
PRIMARY EXAMINER